

REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 20, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

Claims 1, 5-6, 8-11, and 17-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Takeuchi* (U.S. Pat. No. 5,860,644). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Takeuchi* reference. Applicant discusses the *Takeuchi* reference and Applicant's claims in the following.

Applicant's claim 1, for example, provides as follows (emphasis added):

An imaging device, comprising:
a main unit that includes a print mechanism; and
a physically separate auxiliary unit that is positioned below,
couples with, and physically supports the main unit, the auxiliary unit
including an integral document finishing mechanism, wherein the
auxiliary unit has a footprint that is substantially the same as a footprint
of the main unit.

Applicant notes that *Takeuchi* at least does not disclose a physically separate auxiliary device that couples with and physically supports a main unit, "wherein the auxiliary unit has a footprint that is substantially the same as a footprint of the main unit," as recited in claim 1.

In expressing the rejection of claim 1, the Office Action asserts that "the footprint of unit B in *Takeuchi* et al is considered slightly larger than the footprint of unit P, taking into account the overall sizes of the two units, and thus the relationship between the two footprints would qualify within the coverage provided by the phrase

'substantially the same' as recited." Office Action, pages 5-6. Applicant respectfully disagrees for the following reasons.

In examining FIG. 1, the footprint of unit P includes an unlabeled feeder unit on the right side of unit P. As clearly shown, this feeder unit extends past the footprint of unit B in a substantial manner. For example, the feeder unit is of such size that it is not capable of being fully represented in the figure. Likewise, the footprint of unit B includes a receiver tray R unit on the left side of unit B. As clearly shown, this receiver tray R extends past the footprint of unit P in a substantial manner. For example, the receiver tray R is of such size that it is not capable of being fully represented in the figure. As a result, the respective footprints are not substantially the same, and therefore, *Takeuchi* fails to teach or suggest that a footprint of unit B is substantially the same as a footprint of unit P.

For at least the foregoing reason, claim 1 is allowable over *Takeuchi*, as are claims 5-6 and 8-11 that depend from claim 1.

Applicant notes that the other independent claims contain limitations that are not disclosed by *Takeuchi*. Applicant's claim 17, for example, provides as follows (emphasis added):

An imaging device, comprising:
a main unit that includes a printing unit and a media input tray;
and
a physically separate auxiliary unit that couples with and physically supports the main unit in a stacked configuration, the auxiliary unit including a further media input tray and a document finishing mechanism, the document finishing mechanism being accessible from an exterior of the device through a slot provided in the auxiliary unit, wherein the auxiliary unit has a footprint that is substantially the same as the footprint of the main unit and a document is inputted through the slot to undergo a finishing operation.

Applicant observes that *Takeuchi* at least does not disclose a physically separate auxiliary device that couples with and physically supports a main unit, the auxiliary unit including a document finishing mechanism accessible from an exterior of the device through a slot, wherein "a document is inputted through the slot to undergo a finishing operation," as recited in claim 17.

In expressing the rejection of claim 17, the Office Action states that "an opening on the housing wall of the auxiliary unit B would inherently be provided in order for the

user to replenish the media supply to the media input tray F and remove the stacked printed document from the stacker S from outside of the auxiliary unit B." Office Action, page 2.

Regardless as to the veracity of these statements, such an opening in the housing wall, as described in the Office Action, is not, in accordance with the teachings of *Takeuchi*, an opening by which a document is inputted to undergo a finishing operation.

Further, with regard to the Office Action statement that the feature "and a document is inputted through the slot to undergo a finishing operation" does not form any part of the imaging device structure as claimed, Applicant submits that the claimed structure does include a slot that (a) is accessible from the exterior of the device and (b) feeds or inputs a document to the document finishing mechanism.

This claimed feature, however, is not disclosed or taught by the cited art. For example, as clearly shown in FIG. 1 of *Takeuchi*, the stacker S and sorter M are internally fed or inputted documents from internal feed paths from diverter D within printer P.

For at least the foregoing reasons, claim 17 is allowable over *Takeuchi*, as are claims 18-20 that depend from claim 17.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 2-4, 12, 14, and 21-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takeuchi* in view of *Guerrero* (U.S. Pat. No. 6,549,749). Claims 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takeuchi* in view of *Kawahira* (U.S. Patent No. 6,801,750). Applicant respectfully traverses these rejections.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the references do not provide a suggestion or motivation that account for the limitations in Applicant's claims. Specifically, as is identified above in relation to independent claim 1, *Takeuchi* at least does not teach a physically separate auxiliary device that couples with and physically supports a main unit, "wherein the auxiliary unit has a footprint that is substantially the same as a footprint of the main unit." In that *Guerrero* does not remedy this deficiency of the *Takeuchi* reference, Applicant respectfully submits that claims 2-4, 12, and 14, which depend from claim 1, are allowable over the *Takeuchi*/*Guerrero* combination for at least the same reasons that claim 1 is allowable over *Takeuchi*. Further, claim 13 (which depends from claim 1) is allowable over *Takeuchi* in view of *Dim* (U.S. Patent No. 6,460,843) for at least the reason that *Dim* does not remedy the deficiency of the *Takeuchi* reference with regard to claim 1. Also, claims 15 and 16 (which depend from claim 1) are allowable over *Takeuchi* in view of *Kawahira* (U.S. Patent No. 6,801,750) for at least the reason that *Kawahira* does not remedy the deficiency of the *Takeuchi* reference with regard to claim 1.

Applicant notes that the other independent claims contain limitations that are not disclosed by *Takeuchi* in view of *Guerrero*. Applicant's claim 21, for example, provides as follows (emphasis added):

An imaging device, comprising:
a print mechanism;
a media input tray; and
a plurality of integral document finishing mechanisms, each finishing mechanism located in a physically separate auxiliary unit that is positioned below and physically supports the media input tray, each finishing mechanism including at least one of a stapling mechanism, a binding mechanism, a hole punching mechanism, a folding mechanism, and a trimming mechanism, wherein each finishing mechanism is


operable to perform a finishing operation concurrently with another finishing operation being performed by another finishing mechanism.

Applicant notes that *Takeuchi* in view of *Guerrero* at least does not disclose a plurality of integral document finishing mechanisms located in a physically separate auxiliary device that physically supports a media input tray, wherein each finishing mechanism is operable to perform a finishing operation concurrently with another finishing operation being performed by another finishing mechanism," as recited in claim 21. In contrast, *Guerrero* discloses utilization modules that "can be interchanged manually to accomplish different post second registration functions." Col. 6, lines 26-31. Further, the claimed finishing operations are not disclosed in *Takeuchi*. In that *Guerrero* does not remedy this deficiency of the *Takeuchi* reference, and vice versa, Applicant respectfully submits that claims 21 and 22-28 (which depend from claim 21), are allowable over the *Takeuchi*/*Guerrero* combination.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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